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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,245	12/21/2001	Robert Jew	3780-001-27	3401

7590 06/25/2003

Supervisor, Patent Prosecution Services
PIPER MARBURY RUDNICK & WOLFE LLP
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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/024,245	Applicant(s) JEW ET AL.	
	Examiner Lauren Q Wells	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> | 6) <input type="checkbox"/> Other: |

Art Unit: 1617

DETAILED ACTION

Claims 1-20 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 12 is vague and indefinite, as it is confusing. Are not essential fatty acids, essential lipids, as the general recitation of lipids encompasses fatty acids? Are not caprylic acid, caproic acid, capric acid, and linoleic acid, essential fatty acids and essential lipids? Are not phospholipids and lecithins, essential lipids? Furthermore, it is respectfully pointed out that it is not clear what "essential" refers to in description of fatty acids or lipids. What distinguishes essential from non-essential? The specification does not define these terms and one of ordinary skill in the art would not be apprised of their meanings.

(ii) Claims 3 and 4 are vague and indefinite, as the metes and bounds of these claims are unascertainable. Does Applicant mean that any cosmetically acceptable compound comprising an ester can be a carrier in the instant invention? The specification does not define these esters and one of ordinary skill in the art would not be apprised of what esters are being referenced.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1617

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-12, 17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Penska et al (5,851,544).

Penska et al. exemplify an oil-in-water cream comprising 0.15% perfluorodecalin infused with carbon dioxide (propellant and carbon dioxide), water (carrier member), xanthan gum (ingredient for improving skin protection, appearance, moisture or texture), and 0.01% butylated hydroxy toluene (antioxidant). Additionally exemplified is a composition comprising 10% perfluorooctylbromide infused with carbon dioxide, 0.5% xanthan gum, and water. Thus, Penska et al. and the instant invention both teach a composition comprising 0.1-8% carbon dioxide, 92-99% carrier, wherein the carrier comprises water, propellant, antioxidant, and additive. See Examples 3-4 in Col. 9.

It is respectfully pointed out that carbon dioxide can be both the propellant and the active ingredient of instant claim 1.

While the specific step of applying the composition to the skin is not recited, it is respectfully pointed out that cosmetic composition are known in the art to be applied to the skin. Additionally, claim 12 of Penska et al. discloses applying their compositions to the skin.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penska et al. as applied to claims 1, 3, 5-11, 12, 17 and 19-20 above.

The instant invention is directed toward a composition comprising 0.1-8% carbon dioxide, and 92-99% of a dermatologically acceptable carrier, and methods of applying such a composition to the skin.

Penska et al. is applied as discussed above. The reference further teaches that propylene glycols, polyethylene glycols, and glycerin, which is synonymous to glycerol, can be added to the composition as emollients. Such emollients are taught as comprising 0.5-50% of the composition. The references fails to exemplify a composition comprising these polyols. See Col. 4, lines 33-54.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the compositions of Penska et al. as further comprising propylene glycols, polyethylene glycols, or glycerin, because of the expectation of achieving a composition that imparts smoothness and suppleness to the skin, which is a property of emollients.

Claim 2, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penska et al. as applied to claims 1, 3-11, 12, 14-17 and 19-20 above, and further in view of Mackles et al. (5,322,683).

Penska et al. is applied as discussed above. The reference lacks a carrier free of fluorocarbons.

Mackles et al. teach cosmetic aerosol foams for administering a composition to the skin. Aliphatic hydrocarbon propellants, fluorocarbons, dimethyl ether, carbon dioxide, nitrogen, and nitrous oxide are taught as equivalent propellants. See abstract; Col. 8, lines 29-32.

Art Unit: 1617

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute dimethyl ether, carbon dioxide, nitrogen, nitrous oxide, as taught by Mackles et al. for the fluorocarbons of Penska et al. because of the expectation of achieving a cosmetically acceptable aerosol and of achieving similar propellant properties.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Penska et al. as applied to claims 1, 3, 5-11, 12, 17 and 19-20 above, and further in view of Zimmerman et al. (6,074,647)

Penska et al. is applied as discussed above. The reference lacks preferred oxygen carriers.

Zimmerman et al. teach cosmetic compositions for beautifying the skin. Olive oil is taught as an emollient (see Col. 8, lines 45-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add olive oil, as taught by Zimmerman et al., to the composition of Penska et al. because of the expectation of a composition that imparts smoothness and suppleness to the skin, which is a property of an emollient.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for

Application/Control Number: 10/024,245


Page 6

Art Unit: 1617

the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
June 18, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER 6/24/03